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OFFICE OF PETITIONS

In re Application of
Lorraine, et al.
Application No. 10/747,739
Filed: 29 December, 2003
Attorney Docket No. RD25422-1

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ON PETITION

This is a decision on one of two petitions filed on 22 May, 2006—this under 37 C.F.R. §1.137(b).

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

BACKGROUND

The record indicates:

- the instant application was filed on 29 December, 2003, without, *inter alia*, a fully executed oath/declaration;
- on 12 April, 2004, the Office mailed a Notice of Missing Parts indicating, *inter alia*, that a fully executed oath/declaration was required within two months;
- the 6 July, 2004, original petition under 37 C.F.R. §1.47(a) —with, *inter alia*, a statement by Petitioner Paul J. DiConza (Reg. No. 48,418), along with an oath/declaration containing the signature of named co-inventor Lorraine (for himself and on behalf of) but without the signature of named non-signing co-inventor Ronald Alan Kline (Mr. Kline), a narration the statement of, and an averment that the oath or declaration was presented to Mr. Kline and references attached documents—however, while the attached assignment

references (in hand note) a transmittal letter, the transmittal letter was not attached to evidence/demonstrate that the entire application (description, claims, abstract, drawings) was presented to the non-signing inventor Mr. Kline along with the oath or declaration—was dismissed on 5 August, 2005, for that deficiency (in advance of the mailing of the decision, a call was placed to Counsel on 4 August, 2005, and a copy of the letter was to be provided when the petition was resubmitted;

- Petitioner received in the decision of 5 August, 2005, a two- (2-) month period within which to reply and was reminded that “[e]xtensions of time under 37 C.F.R. §1.136(a) are permitted,” however, after the expiration of the reply period on 5 October, 2005, the maximum extension of five (5) months would have expired on 5 March, 2006, and the record is clear that Petitioner’s Certificate of Mailing is set forth as “April 3, 2006”—thus the petition was dismissed on 17 April, 2006, because the instant application went abandoned after midnight 5 October, 2005;
- with the instant petition to revive under 37 C.F.R. §1.137(b), Petitioner also submitted a companion renewed petition—as the required reply for the petition to revive—under 37 C.F.R. §1.47, and because that is grantable and the instant petition also is accompanied as required by the fee and a statement of unintentional delay, Petitioner now appears to have satisfied the regulatory requirements under 37 C.F.R. §1.137(b).

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).¹

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.²

¹ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

² Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

Delays in responding properly raise the question whether delays are unavoidable.³ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁴ And the Petitioner must be diligent in attending to the matter.⁵ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁶))

Allegations as to
Unintentional Delay

The requirements for relief under the provisions of 37 C.F.R. §1.137(b) are: petition, fee, reply, showing of unintentional delay, and—where appropriate—a terminal disclaimer and fee.

It appears that Petitioner has satisfied the requirements of the regulation.

CONCLUSION

Because Petitioner appears to have satisfied the regulatory requirements, regulation, the petition under 37 C.F.R. §1.137(b) is **granted**.

The application is released to the Examiner in Technology Center 2800 for further processing as required before being forwarded to Publications Branch in due course.

³ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁴ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁵ See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

⁶ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

A handwritten signature in black ink, appearing to be 'J. Gillon, Jr.', with a stylized flourish at the end.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions